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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/907,230

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Trung V. Le

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06/06/2006

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EXAMINER

SCHUBERT, KEVIN R

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/907,230

Applicant(s)

LE ET AL.

Examiner

Kevin Schubert

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-31 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-31 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 3/14/06.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-4,6,8-31, and 33-38 have been considered. Examiner notes his appreciation for Applicant's time and efforts in the telephonic interview which took place March 14, 2006.

5

Allowable Subject Matter

The subject matter of claims 13 and 33-34 appears to be allowable if the claims are rewritten in independent form, including any intervening claim, with the base claim and the 112 issues are resolved.

Claim Objections

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Claims 24-28 are objected to because of the following informalities: the refer to "the data storage device of claim 23". The language of claim 23 appears to be a computer-readable medium, not a data storage device. Appropriate correction is required.

Claim Rejections - 35 USC § 101

15

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

20

Claims 1-4,6,8-31, and 33-38 are rejected under 35 U.S.C. 101 as lacking patentable utility. The claims denote a "method of preventing creation of unauthorized and accessible copies of a medium" (e.g. claim 1). In contrast to this asserted utility, the claims appear to teach a method in which unauthorized and accessible copies are created. The claims, as presented, do not appear to have patentable utility.

25

Appropriate correction.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

30

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4,6,8-31, and 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.

5 See MPEP § 2172.01. More specifically, Applicant claims "a method of preventing creation of unauthorized and accessible copies of a medium" (e.g. claim 1). However, the method steps do not describe a method of preventing creation of unauthorized and accessible copies of a medium. In contrast, the method steps appear to teach creation of unauthorized and accessible copies, the copies containing a second access key. Thus, Applicant has omitted an essential element(s) which denotes
10 *preventing creation of unauthorized and accessible copies of a medium.*

Claims 1-4,6,8-31, and 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the phrase "due to the application of the error correction
15 information to the uncorrected data" (e.g. claim 1 line 13) refers to the "modifi[cation] relative to the access key" or the "facilitat[ing] access to the digital content on the medium". Appropriate correction is required.

Claims 1-4,6,8-31, and 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being
20 indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant refers to "the medium" in claim 1, line 14. Applicant's claimed invention calls for two mediums. It is unclear which medium Applicant refers to. Appropriate correction is required. Examiner notes that dependent claims 2-4,6,9,13,16-19,21,31, and 38 appear to have additional reference problems associated with their reference to "the medium". Appropriate correction is required.

25

Claims 33-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Applicant refers to "the access key" (claim 33 line 3). However, Applicant's claimed invention calls for two access keys. It is unclear which access key Applicant refers to. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

10 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15 Claims 1-4,6,8-10,12,14-31, and 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Sims, U.S. Patent No. 6,438,235.

20 As per claims 1,15,23, and 29, the applicant describes a computer-readable medium comprising the following limitations which are met by Sims:

- a) digital content (Col 9, lines 19-39, claim 26);
- b) an access key that facilitates access to the digital content on the medium and prevents creation of unauthorized copies of the medium, wherein the access key includes uncorrected data and associated error correction information having one or more errors (Col 9, lines 19-39, claim 26);
- 25 c) an executable software application to control access to the digital content based on the uncorrected data by applying the error correction information to the uncorrected data to produce a second access key when the digital content is copied from the medium to a second medium, wherein the second access key is modified relative to the access key that facilitates access to the digital content on the medium to the application of the error correction information to the uncorrected data, and wherein the
- 30 second access key is copied to the second medium as its respective access key (Col 9, lines 19-39, claim 26).

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As per claims 2 and 16, the applicant describes the method of claims 1 and 15, which are met by Sims, with the following limitation which is met by Sims:

- a) invoking a device driver of a storage device to read the uncorrected data from the medium
- 5 without modification from application of the error correction information (Col 9, lines 19-39);
- b) comparing the uncorrected data and the input (Col 9, lines 19-39);

As per claims 3 and 17, the applicant describes the method of claims 1 and 15, which are met by Sims, with the following limitation which is met by Sims:

- 10 Wherein controlling access to the medium includes installing a software application from the medium onto a computing system (Col 9, lines 19-39).

As per claims 4, 18, 24, and 36, the applicant describes the method of claims 1, 15, 23, and 29, which are met by Sims, with the following limitation which is met by Sims:

- 15 Wherein controlling access to the medium includes executing a software application from the medium (Col 9, lines 19-39).

As per claims 6, 19, 25, and 35, the applicant describes the method of claims 1, 15, 23, and 29, which are met by Sims, with the following limitation which is also met by Sims:

- 20 Wherein controlling access to the medium includes producing an audio output based on content stored on the medium (Col 9, lines 19-39).

As per claims 8 and 20, the applicant describes the method of claims 1 and 15, which are met by Sims, with the following limitation which is also met by Sims:

- 25 Wherein the error correction information includes error correction information selected from an error correction code, a cyclic redundancy code, and a Cross Interleaved Reed-Solomon Code (Col 9, lines 19-39, claim 26).

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As per claims 9 and 21, the applicant describes the method of claims 1 and 15, which are met by Sims, with the following limitation which is also met by Sims:

Wherein controlling access to the digital content on the medium comprises decrypting the digital
5 content contained within the medium based on the uncorrected data and the input (Col 9, lines 19-39).

As per claim 10, the applicant describes the method of claim 9, which is met by Sims, with the following additional limitation which is also met by Sims:

Wherein the digital content comprises at least one of a software application, audio data, or video
10 data (Col 9, lines 19-39).

As per claim 12, the applicant describes the method of claim 1, which is met by Sims, with the following limitation which is also met by Sims:

Further including selecting the access key from a plurality of access keys, where each of the
15 access keys includes data and associated error correction information, having one or more errors (Col 9, lines 19-29).

As per claims 14,22,28, and 37, the applicant describes the method of claims 1,15,23, and 29, which are met by Sims, with the following limitation which is met by Sims:

Wherein the uncorrected data includes accurate error correction information for the uncorrected
20 data (Col 9, lines 19-29).

As per claim 26, the applicant describes the data storage device of claim 23, which is met by Sims, with the following limitation which is also met by Sims:

Wherein the error correction information includes an incorrect cyclic redundancy code (Col 9,
25 lines 19-29).

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As per claim 27, the applicant describes the data storage device of claim 23, which is met by Sims, with the following limitation which is also met by Sims:

Wherein the error correction information causes the uncorrected data to be changed when the computer-readable medium is copied (Col 9, lines 19-29).

5

As per claims 30 and 31, the applicant describes the method of claims 29, which are met by Sims, with the following limitation which is met by Sims:

Wherein associating content and the access key comprises communicating the digital content and the access key through a transmission medium (Col 9, lines 19-29).

10

As per claim 38, the applicant describes the method of claim 1, which is met by Sims, with the following limitation which is also met by Sims:

Wherein the access key comprises a cryptographic access key that facilitates decryption of the digital content on the medium (Col 9, lines 19-29).

15

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sims in view of Schneier (Schneier, Bruce. Applied Cryptography. John Wiley & Sons. 1996. pages 176-179).

30

As per claim 11, the applicant describes the method of claim 1, which is met by Sims, with the following limitation which is met by Schneier:

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Wherein receiving the access key includes decrypting the access key (Schneier: page 176-177).

Sims discloses all the limitations of claim 1. However, in Sims it does not appear that the access key, itself, is decrypted. Schneier discloses that an access key may be decrypted by another key. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Schneier with those of Sims because doing so increases the security and protection of the key.

Response to Arguments

Applicant's arguments with respect to the 102(b) rejection of claim 1 under Sollish have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application
5 Information Retrieval (PAIR) system. Status information for published applications may be obtained from
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10 or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-
1000.

KS

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